

PATENT
4140-0112PUS1

IN THE U.S. PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Gordon COOK et al.

Application No.: 10/523,023

Confirmation No.: 7457

Filed: February 1, 2005

Art Unit: 3772

For: AN INFLATABLE DEVICE FOR USE IN
IMPULSE THERAPY

Examiner: Michael A. Brown

REPLY BRIEF UNDER 37 C.F.R. § 41.41

MS. Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Appellants hereby reply to the Examiner's responses in the Examiner's Answer to
Appellant's arguments in the Appeal Brief filed on August 31, 2007.

I. On pages 5 and 6 of the Examiner's Answer, the Examiner continues to speculatively conclude that ". . . it is inherent that the foam material (34) . . . is a means for dissipating the flow of fluid into the bladder while at the same time reducing noise during pressurization of the bladder." In support of this speculative conclusion, the only statement in support thereof is "[T]he foam material will dissipate the flow of fluid in the bladder." Unfortunately, this statement is also a speculative conclusion.

In response to this, Appellants respectfully submit that it is well settled that a rejection under 35 U.S.C. §103 cannot properly be based on speculation but must be based on objective factual evidence of record. See, In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968). See, also, In re GPAC Inc., 35 USPQ2d 1116 at 1123 (Fed. Cir. 1995) and Ex parte Haymond, 41 USPQ2d 1217 at 1220 (Bd. Pat. App. & Int. 1996). Furthermore, a factual inquiry whether to modify a reference must be based on objective evidence of record, not merely conclusory statements of the Examiner. See, In re Lee, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002).

Unfortunately, absolutely no objective factual evidence of record is presented to support a conclusion that the foam of Johnson '262, which is not located in a pump-inflatable chamber, is a means for dissipating the flow of fluid into the bladder while at the same time reducing noise during pressurization of the bladder, as claimed. In this regard, Appellants respectfully submit that Johnson '262 employs four separate chambers 8, 9, 10 and 11, with urethane foam in only two of these chambers, i.e., chambers 8 and 9. Significantly, no foam is located in either

inflatable chamber. Accordingly, there is no foam on which the air used to inflate the device impinges. In the absence of such a disclosure, it is not clear to Appellants how the foam of Johnson '262 dissipates the flow of air that does not impinge on it, or reduces noise caused by air inflating the device where the air does not impinge on the foam. The Office Action never addresses this issue.

Furthermore, the Office Action does not reply to the merits of Appellants' arguments that for something to be inherently disclosed, it must be disclosed not just possibly, and not just probably, but it must be necessarily disclosed. Reference is made in this regard to Rosco v. Mirro Lite, 304 F.3d 1373, 1380, 64 USPQ2d 1676 (Fed. Cir. 2002), which indicates that a claim limitation is inherent in the prior art if it is necessarily present in the prior art, not merely probably or possibly present.

Accordingly, the Office Action does not make out a *prima facie* case of anticipation of claims 1, 2, 7, 9 and 10 by Johnson '262.

II. On page 7 of the Examiner's Answer, the Examiner addresses the Gorran reference, which was used in combination with Johnson '262 to reject dependent claims 3 and 11, which recite that the volume-reducing internal component is a gel, as an equivalent to a foam. The Examiner speculatively concludes that the gel and the foam are equivalent because both can be used to reduce the internal volume, dissipate the flow of fluid and reduce noise pressurization. However, as noted above, the Examiner has presented no objective factual evidence that Johnson 262's urethane foam located in chambers 8 and 9 necessarily performs the

claimed invention, and the assertion that Gorran's gel will do something that the Office Action has failed to provide evidence that Johnson 262's urethane foam in chambers 8 and 9 will necessarily do, is nothing more than improper speculation and fails to provide a *prima facie* case of an inherent disclosure of the claimed invention of claims 3 and 11.

Accordingly, the Office Action does not make out a *prima facie* case of obviousness of claims 3 and 11 over Johnson '262 in view of Gorran.

II. On page 5 of the Examiner's Answer, the Examiner discusses both Johnson '262 and Johnson '945, and agrees that they disclose the same foam, this agreeing with Appellants in this regard. The Examiner's Answer still fails to respond to the arguments presented by Appellants on pages 16 and 17 of the Appeal brief, thereby tacitly agreeing with them.

Accordingly, the Office Action does not make out a *prima facie* case of obviousness of claim 5 over Johnson '262 in view of Johnson '262 (or Johnson '945).

III. On page 7 of the Examiner's Answer, the Examiner discusses the Grim reference, which is applied in the rejection of dependent claim 6 by continuing to fail to address the arguments presented by Appellants on pages 18 and 19 of the Appeal Brief, which address the lack of incentive or reasons that one of ordinary skill in the art would have to turn to Grim to modify Johnson '262. This failure is a tacit admission of the correctness of Appellants' arguments in this regard.

Accordingly, the Office Action does not make out a *prima facie* case of obviousness of claim 6 over Johnson '262 in view of Grim.

IV. The Examiner's Answer completely fails to address Appellants' arguments on page 7 that the Examiner has made a clear, unmistakable and unequivocal admission on page 4 of the final Office Action that the Office Action does not make out a *prima facie* case of anticipation of claims 1, 2, 7 and 9-10 by Johnson '262. This is a tacit admission that Appellants' arguments in this regard are correct.

Accordingly, Appellants respectfully submit that the final Office Action fails to make out a *prima facie* case of unpatentability of claims 1-3, 5-7 and 9-11, and respectfully request that the final rejections of 1-3, 5-7 and 9-11 are improper and should be reversed.

A Request for an Oral Hearing is being filed on even date herewith.

Respectfully submitted,

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